

REMARKS

Claim 10 has been amended. Thus, claims 10, 14-18 and 21-33 are pending in the present application. Support for the amendment to claim 10 may be found in corresponding US Patent Publication No. 2006/0240343 at paragraphs [0011], [0013] and [0014]. Thus, no new matter has been added. Reconsideration and withdrawal of the rejections in view of the comments presented herein are respectfully requested.

Interview Summary

Applicants' representatives would like to thank Examiners Zhang and Huff for the courtesy extended to them during the telephonic interview conducted on April 28, 2011. The substance of this interview is reflected in the amendments and remarks presented herein.

Rejection under 35 U.S.C. 103(a)

Applicant presents the following additional comments regarding the rejection of claims 9-19, 22-30 and 33 under 35 U.S.C. §103(a) as allegedly being unpatentable over Dukler (WO 00/78556) in view of Nagashima (US 4,148,968), and claims 20, 21, 31, and 32 under 35 U.S.C. §103(a) as allegedly being unpatentable over the same combination of references, and further in view of Yanaka (US 2003/0068575).

Dukler discloses a fluorescent ink which results in an invisible image that can only be seen upon illumination with UV light. This image is not created by reaction with a substrate containing a complementary reactant as recited in the present claims.

Nagashima discloses a toner (reactant) containing a color forming agent, and a reaction that creates a colored, fixed image embedded in the substrate. In contrast, present claim 10 as amended recites that the security feature comprises a fluorescent or chemically-detectable image having the same configuration as the toner image, and that the fluorescent image is invisible under normal lighting conditions but visible when illuminated with UV light and the chemically-detectable image is revealed by application of a complementary reagent which reacts to produce a color, such that said security feature provides covert security. Thus, the recited security feature provides embedded, invisible images, which are only visible upon UV illumination or application of a complementary reagent. As discussed during the interview, the importance of retaining an invisible security feature embedded in the substrate is in preventing fraudulent alteration of a

document. For example, if a forger tries to alter an amount written on a check by removal ("scraping away") a decimal point or comma, the security feature cannot be removed because it remains embedded in the substrate, and can be visualized with UV light, or by application of a complementary reagent. Thus, the forger will believe that the document has been cleanly altered. However, the retained security feature can be visualized by a bank or other institution to determine that an attempt at forgery has occurred. Thus, the security feature being visible only under the recited conditions is an important feature of the claimed invention that distinguishes the invention from the prior art.

In contrast to the presently claimed invisible security feature, Nagashima discloses a visible image that is created by a combination of a reactant and a complementary reactant, this feature produces an image that is visible under ordinary conditions. Neither Nagashima nor Dukler discloses or suggests the combination of a reactant and complementary reactant to form an invisible security feature that is retained in or on the substrate in the event of fraudulent alteration or removal of the toner image as recited in present claim 10. Yanaka teaches nothing to remedy the deficiencies in the teaching of Dukler or Nagashima et al. Thus, the combination of Dukler and Nagashima et al. (with or without Yanaka) would not result in the invention recited in present claim 10, and claim 10 should therefore be patentable over this combination of references. Since claims 14, 15, 17, 18, 21 and 22 depend on claim 10, these claims should also be patentable over these references.

With regard to Claim 16, Applicants wish to note that an alteration using plain ink after removal of the original image in Dukler might result in the security feature being different than the visible image. However, in Dukler, if the toner image is fraudulently removed or altered as recited in the last step of claim 16, the security feature would be removed as well, and would not be identical to the original toner image. Moreover, an unexpected advantage of the invention recited in claim 16 is that it can detect fraudulent activity in which all or part of the toner image is removed without further alteration. In contrast, since the security feature in Dukler would not be retained on the substrate after alteration or removal, the Dukler method could not detect any fraudulent activity if all or part of the original image were removed without attempting to further alter the image.

Thus, since Dukler discloses nothing about retaining a security feature on the substrate and Nagashima discloses no security feature whatsoever, this claim is clearly patentable over

Nagashima in view of Dukler. Since claims 23-33 depend either directly or indirectly on claim 16, these claims should also be patentable over these references.

In view of the comments presented above, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a).

No Disclaimers or Disavowals

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicant is not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

CONCLUSION

Applicants submit that all claims are in condition for allowance. Should there be any questions concerning this application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Respectfully submitted,

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